

REMARKS

Claims 1–20 are pending in the present application.

Claims 1–5, 16–17 and 19–20 were amended herein; claim 18 was canceled.

Reconsideration of the claims is respectfully requested.

35 U.S.C. § 102 (Anticipation)

Claims 1–3 and 16–18 were rejected under 35 U.S.C. § 102(e) as being anticipated by EP 0690638 to *Lerman*. This rejection is respectfully traversed.

A claim is anticipated only if each and every element is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the claim. MPEP § 2131 at p. 2100-73 (8th ed. rev. 2 May 2004).

Amended independent claims 1 and 16 each recite that a single mobile station communicates with a local-network radio transceiver positioned at one the first or second fixed-site subscriber stations, and specifically with one local-network radio transceiver when a corresponding one of the fixed-site subscriber stations within a selected but with the other local-network radio transceiver when the mobile station moves outside the selected range from the one fixed-site subscriber station but within the selected range from the other. Such a feature is not found in the cited reference.

Therefore, the rejection of claims 1–3 and 16–18 under 35 U.S.C. § 102 has been overcome.

35 U.S.C. § 103 (Obviousness)

Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lerman* in view of U.S. Patent No. 5,115,463 to *Moldavsky et al* and further in view of U.S. Patent No. 5,416,831 to *Chewning, II et al.* Claims 5–10 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lerman* in view of U.S. Patent No. 5,673,307 to *Holland et al.* Claims 11–15 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lerman* in view of *Holland et al* and further in view of U.S. Patent No. 5,901,352 to *St. Pierre et al.* This rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142, p. 2100-128 (8th ed. rev. 2 May 2004). Absent such a *prima facie* case, the applicant is under no obligation to produce evidence of nonobviousness. *Id.*

To establish a *prima facie* case of obviousness, three basic criteria must be met: First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *Id.*

Independent claim 5 recites that the single mobile station communicates with both the first and second local-network transceivers depending on which is within a selected range. Such a feature is not found in the cited reference. *Lerman* teaches a mobile station 38 communicating with one or the other of base transceiver 14 or second converter 44 depending on whether the mobile station 38 is in an indoor environment or an outdoor environment, not based on whether the mobile stations 38 is within a selected range of base transceiver 14 or second converter 44.

Independent claim 19 recites handing off when the mobile station moves between coverage areas. Such a feature is not found in the cited reference. *Lerman* makes not mention of hand-off, or even of communication while mobile station 38 is in movement.

Therefore, the rejection of claims 4–15 and 19–20 under 35 U.S.C. § 103 has been overcome.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *dvenglarik@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: 8-9-04



Daniel E. Venglarik
Registration No. 39,409

P.O. Drawer 800889
Dallas, Texas 75380
(972) 628-3621 (direct dial)
(972) 628-3600 (main number)
(972) 628-3616 (fax)
E-mail: *dvenglarik@davismunck.com*